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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,889	08/17/2001	Toshihide Sekido	360842008200	5982

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EXAMINER
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STAICOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 12/05/2002

b

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/913,889

Applicant(s)

SEKIDO ET AL.

Examiner

Stefan Staicovici

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-35 is/are pending in the application.
- 4a) Of the above claim(s) 18-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-17, 34-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- a. Group I, claim(s) 1-12, 14-17 and 34-35 drawn to a method of making a fiber-reinforced plastic tubular body.

- b. Group II, claim(s) 18-33, drawn to a fiber-reinforced plastic tubular body.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the technical feature “integrally coupled” in claims 18 and 27 does not refer to the same technical feature. Specifically, in claim 18, the layers of resin distribution medium and FRP material are “integrally coupled” in a concentric direction whereas, in claim 27, two or more components are “integrally coupled” in a circumferential direction to form a FRL tubular body. Therefore, the only structural feature common to claims 1, 18 and 27 is a FRP tubular body that is not new as evidenced hereinafter.

Furthermore, the problems to be solved by the claimed inventions of claims 1 and 18 on one side, and 27 on the other side, are not related to each other. Specifically, the technical problem to be solved by claims 1 and 18 is to build a one-piece tubular article using unitary

structures, whereas claims 17 and 27 pertain to build a large diameter tubular article from a plurality of smaller sections using connecting members.

Hence, the instant application contains two distinct inventions with different technical features that determine different and independent functions and solve different technical problems and as such, a unifying inventive concept cannot be recognized.

3. During a telephone conversation with Mr. Barry Bretschneider on October 11, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12, 14-17 and 34-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 10-11, 15 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Tunis, III *et al.* (US Patent No. 6,159,414).

Tunis, III *et al.* ('414) teach the claimed process of making a fiber reinforced tubular body including, arranging a resin distribution medium (64) and a fiber reinforced layer (66) about a solid core (60) to form a wrapped assembly, covering said wrapped assembly with an airtight covering (68), drawing a vacuum and injecting a resin through said distribution resin medium (64) to impregnate said fiber reinforced layer (66) and produce said fiber reinforced tubular body (see Figures 6 and 7 and, col. 6, lines 18-44). Further, it should be noted that since Tunis, III *et al.* ('414) teach that the "the fiber material may be supplied in a tubular form into which the core is inserted" (see col. 4, lines 21-22), it is submitted that a fiber reinforced tubular plastic body results (see also Figure 16A).

In regard to claims 2-3, Tunis, III *et al.* ('414) teach a resin distribution system including large longitudinal groove (14) and a plurality of transversal, smaller grooves (18) (see Figure 1).

Specifically regarding claim 4, Tunis, III *et al.* ('414) teach a resin distribution system including a reticulate material (see Figure 6).

Regarding claim 5, Tunis, III *et al.* ('414) teach the fiber reinforced layer (64) positioned between resin distribution medium (150) of a vacuum bag and the core material (60) having resin distribution grooves (see col. 9, lines 18-30).

In regard to claim 10, since Tunis, III *et al.* ('414) teach a resin distribution system including large longitudinal groove (14) and a plurality of transversal, smaller grooves (18) (see

Figure 1) and a process including drawing a vacuum which forces a resin material to travel through said grooves, it is submitted that said large longitudinal groove also serves as a vacuum suction line in order for the invention of Tunis, III *et al.* ('414) to function as described.

Specifically regarding claims 11, 15-16 and 34, Tunis, III *et al.* ('414) teach wrapping said fiber reinforcement layers (66) around a plurality of cores and integrating said wrapped separate cores into an integral boat hull (circumferential direction). It is submitted that wrapping occurs with a degree of tension in order to maintain the fiber reinforced layers about said cores and as such in order for the invention of Tunis, III *et al.* ('414) to function as described. Further, it should be noted that Tunis, III *et al.* ('414) specifically teach that the cores may take any shape and be arranged in any suitable pattern, hence a circumferential pattern since a boat hull is fabricated.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-79649.

JP 2000-79649 teaches the claimed process of making a fiber reinforced tubular article including, providing a hollow core (2), wrapping said core with a resin distribution medium and a fiber reinforced layer (4) to form an assembly, covering said assembly with an air-tight covering (6), drawing a vacuum (7) and injecting a resin (9) to form said tubular fiber reinforced article (see English translation Abstract).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 10-11, 14 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekido *et al.* (US Patent No. 5,960,834) in view of Tunis, III *et al.* (US Patent No. 6,159,414).

Sekido *et al.* ('834) teach the basic claimed process of forming a tubular fiber reinforced article including, providing an expansive tubular mandrel (1), wrapping a layer of fibers (2) and a layer of woven fabric (5) about said mandrel (1) to form a wrapped assembly, placing said wrapped assembly in an air-tight mold (covering), drawing a vacuum onto the interior of said mold, injecting a resin into said mold to impregnate said assembly and curing said assembly to form said tubular fiber reinforced article (see Figure 1 and col. 21, line 21 through col. 22, line 5).

Regarding claim 1, Sekido *et al.* ('834) do not teach a resin distribution medium. Tunis, III *et al.* ('414) teach the claimed process of making a fiber reinforced tubular body including, arranging a resin distribution medium (64) and a fiber reinforced layer (66) about a solid core (60) to form a wrapped assembly, covering said wrapped assembly with an airtight covering (68), drawing a vacuum and injecting a resin through said distribution resin medium (64) to impregnate said fiber reinforced layer (66) and produce said fiber reinforced tubular body (see

Figures 6 and 7 and, col. 6, lines 18-44). Further, it should be noted that since Tunis, III *et al.* ('414) teach that the "the fiber material may be supplied in a tubular form into which the core is inserted" (see col. 4, lines 21-22), it is submitted that a fiber reinforced tubular plastic body results and that a tubular core is used. Therefore, it would have been obvious for one of ordinary skill in the art to have provided a resin distribution medium as taught by Tunis, III *et al.* ('414) in the process of Sekido *et al.* ('834) because, Tunis, III *et al.* ('414) specifically teach that a resin distribution medium provides for uniform impregnation and as such improved shear strength of the resulting article (see col. 2, lines 40-55).

In regard to claims 2-4, Tunis, III *et al.* ('414) teach a resin distribution system including large longitudinal groove (14) and a plurality of transversal, smaller grooves (18) (see Figure 1) and a reticulate material (see Figure 6). Therefore, it would have been obvious for one of ordinary skill in the art to have provided a resin distribution medium as taught by Tunis, III *et al.* ('414) in the process of Sekido *et al.* ('834) because, Tunis, III *et al.* ('414) specifically teach that a resin distribution medium provides for uniform impregnation and as such improved shear strength of the resulting article (see col. 2, lines 40-55).

Specifically regarding claim 10, since Tunis, III *et al.* ('414) teach a resin distribution system including large longitudinal groove (14) and a plurality of transversal, smaller grooves (18) (see Figure 1) and a process including drawing a vacuum which forces a resin material to travel through said grooves, it is submitted that said large longitudinal groove also serves as a vacuum suction line in order for the invention of Tunis, III *et al.* ('414) to function as described. Therefore, it would have been obvious for one of ordinary skill in the art to have provided a resin



distribution medium that acts as a vacuum channel as taught by Tunis, III *et al.* ('414) in the process of Sekido *et al.* ('834) because, Tunis, III *et al.* ('414) specifically teach that a resin distribution medium provides for uniform impregnation and as such improved shear strength of the resulting article (see col. 2, lines 40-55).

Regarding claim 11 Sekido *et al.* ('834) teach wrapping a layer of fibers (2) and a layer of woven fabric (5) about said mandrel (1).

In regard to claims 14 and 35, Sekido *et al.* ('834) teach applying an internal pressure to expansive tubular mandrel (1). Further, Sekido *et al.* ('834) teach a process for making a curved tubular fiber reinforced plastic body, specifically a tennis racket having a curved portion (frame) and a straight portion (handle) (see Figure 33).

10. Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson *et al.* (US Patent No. 6,248,024) in view of Tunis, III *et al.* (US Patent No. 6,159,414) or JP 2000-79649.

Nelson *et al.* ('024) teach the basic claimed process of forming a tubular fiber reinforced article including, providing a core, wrapping said mandrel with a bladder (release material), wrapping said bladder with a fiber reinforced material to form a wrapped assembly, placing said wrapped assembly in a mold, drawing a vacuum, injecting a resin into said mold and curing said resin to form said tubular fiber reinforce material (see col. 12, lines 35-40; col. 13, lines 30-50; col. 14, lines 6-15). Further, Nelson *et al.* ('024) teach removing said core and said bladder (release material) (see 15, lines 17-37).

Regarding claim 1, Nelson *et al.* ('024) do not teach a resin distribution medium. Tunis, III *et al.* ('414) teach a process for making a fiber reinforced tubular body including, arranging a resin distribution medium (64) and a fiber reinforced layer (66) about a solid core (60) to form a wrapped assembly, covering said wrapped assembly with an airtight covering (68), drawing a vacuum and injecting a resin through said distribution resin medium (64) to impregnate said fiber reinforced layer (66) and produce said fiber reinforced tubular body (see Figures 6 and 7 and, col. 6, lines 18-44). Further, it should be noted that since Tunis, III *et al.* ('414) teach that the "the fiber material may be supplied in a tubular form into which the core is inserted" (see col. 4, lines 21-22), it is submitted that a fiber reinforced tubular plastic body results and that a tubular core is used. JP 2000-79649 teaches a process for making a fiber reinforced tubular article including, providing a hollow core (2), wrapping said core with a resin distribution medium and a fiber reinforced layer (4) to form an assembly, covering said assembly with an air-tight covering (6), drawing a vacuum (7) and injecting a resin (9) to form said tubular fiber reinforced article (see English translation Abstract). Therefore, it would have been obvious for one of ordinary skill in the art to have provided a resin distribution medium as taught by Tunis, III *et al.* ('414) or JP 2000-79649 in the process of Sekido *et al.* ('834) because, Tunis, III *et al.* ('414) specifically teach that a resin distribution medium provides for uniform impregnation and as such improved shear strength of the resulting article (see col. 2, lines 40-55), and also because all references teach similar materials and processes.

11. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekido *et al.* (US Patent No. 5,960,834) in view of Tunis, III *et al.* (US Patent No. 6,159,414) and in further view of McClure *et al.* (US Patent No. 6,090,335).

Sekido *et al.* ('834) in view of Tunis, III *et al.* ('414) teach the basic claimed process as described above.

Regarding claim 6, Sekido *et al.* ('834) in view of Tunis, III *et al.* ('414) do not teach a lengthwise lowermost resin line and an upper most vacuum line in regard to the resin distribution medium. McClure *et al.* ('335) teach a vacuum resin impregnation process including providing a fiber reinforced layer covered by an air-tight vacuum bag, an uppermost vacuum line (30) and a plurality of lowermost resin lines (40), such that as a vacuum is drawn across the inside of the vacuum bag resin is pulled through the fiber reinforced layer (see Figure 2). Therefore, it would have been obvious for one of ordinary skill in the art to have provided a lowermost resin line and an upper most vacuum line as taught by McClure *et al.* ('335) because, McClure *et al.* ('335) specifically teach that such an arrangement provides for resin flow to occur when a vacuum is drawn over the interior of a mold, whereas Sekido *et al.* ('834) teach a mold impregnation process requiring a vacuum be formed while a resin is being distributed, hence in order for the invention of Sekido *et al.* ('834) in view of Tunis, III *et al.* ('414) to function as described.

In regard to claims 7-9, Sekido *et al.* ('834) teach a plurality of resin lines. Further, Sekido *et al.* ('834) teach that the number and position of the resin lines can be used to optimize the molding conditions and that the resin line and the vacuum line are interchangeable (see col. 23, line 61 through col. 24, line 4). It is submitted that the number and position of the resin and

vacuum lines is a mere result-effective variable. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Therefore, it would have been obvious for one of ordinary skill in the art to have used routine experimentation to determine the number and position of the vacuum and resin lines in the process of Sekido *et al.* ('834) in view of Tunis, III *et al.* ('414) and in further view of McClure *et al.* ('335) because, Sekido *et al.* ('834) specifically teach that the number and position of the resin lines can be used to optimize the molding conditions.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tunis, III *et al.* (US Patent No. 6,159,414) in view of Nakamura (US Patent No. 6,350,337 B1).

Tunis, III *et al.* ('414) teach the basic claimed process as described above.

Regarding claim 17, Tunis, III *et al.* ('414) do not teach connecting member. However, the use of connecting members to form a complex shaped article is well known the art as evidenced by Nakamura ('337) that teaches a process for molding tubular fiber reinforced articles including a plurality of cores wrapped with fiber reinforced material, placing said wrapped cores into a mold, injecting resin into said mold and curing said resin to form a tubular fiber reinforced article, wherein said plurality of cores are connected by connecting members (122) (see Figure 14). Therefore, it would have been obvious for one of ordinary skill in the art to have provided connecting members to connect a plurality of cores as taught by Nakamura ('337) in the process of Tunis, III *et al.* ('414) due to a variety of advantages such as increased versatility by obtaining complex shapes and also because Tunis, III *et al.* ('414) specifically teach molding a plurality of cores into an integral article, whereas Nakamura ('337) teach connecting a plurality of cores in order to obtain a complex shape that can be molded.

*Conclusion*

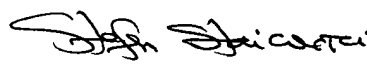
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because the general knowledge in the prior art is shown.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached at (703) 308-3829. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD

  
AU 1732 12/02/02

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December 2, 2002